

Appl. No.: 09/913,378  
Response dated February 3, 2004  
Reply to Office action of December 8, 2003

#### REMARKS/ARGUMENTS

Favorable consideration and allowance of the instant application is respectfully requested in view of the following remarks.

The Examiner's rejections, as they pertain to the patentability of the claims, are respectfully traversed.

Claims 10-23 remain rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over de Haut et al. (US 6,207,014). This rejection is again respectfully traversed for the following reasons.

With regards to the 35 U.S.C. § 102(e) rejection, Applicant again respectfully submits that the '014 reference fails to anticipate the claimed invention, for the reason that it fails to disclose the use of each and every element of the claimed invention. It is extremely well settled that a factual determination of anticipation requires the disclosure, in a single reference, of each and every element of the claimed invention, and an Examiner must identify wherein each and every facet of the claimed invention is disclosed in the applied reference. See, *in re Levy*, 17 USPQ2d 1561 (Bd. Pat. App. & Inter. 1990). It is Applicant's position that the '014 reference fails to anticipate the claimed invention on the grounds that each and every element thereof is NOT disclosed by said reference. More particularly, the '014 reference fails to disclose a combination of the claimed polyol poly-12-hydroxystearate, the claimed wax component, and the claimed amount of wax ester in an emulsion composition. On the contrary, the '014 reference clearly discloses that neither the polyol poly-12-hydroxystearate nor the wax component are required in its lotion. As a result, this reference clearly cannot serve to anticipate the claimed invention.

With regards to the obviousness rejection, Applicant again respectfully submits that the '014 reference fails to contain the requisite teaching or suggestion to **motivate** one

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skilled in the art to wish to employ: (1) the claimed polyol poly-12-hydroxystearate; (2) the claimed wax component; and (3) the claimed amount of wax ester in its emulsion composition. With regards to the claimed polyol poly-12-hydroxystearate, the '014 reference clearly teaches the use of an emulsifier, **in general**, as being merely optional. However, in the event that a routineer would choose to employ an emulsifier, this reference teaches two types of surfactants from which to choose, i.e., nonionic surfactants and/or amphoteric surfactants. Now, in the event that the routineer would, for some reason not evident from the disclosure of the '014 reference, choose to employ a nonionic surfactant, this reference then teaches 5 classes of nonionic surfactants, each class having numerous candidates from which to choose, one of which being the claimed polyol poly-12-hydroxystearate. Clearly, numerous critical decisions would need to be made in order for the routineer to arrive at selected the claimed for use in the '014 formulation, none of which appear to be motivated based on the teachings of the reference.

This being the case, Applicant would again like to note that it is well settled that that which is within the capabilities of one skilled in the art is not synonymous with obviousness. See, Ex parte Gerlach, 212 USPQ 471 (Bd. Pat. App. & Inter. 1980). In Ex parte Wittpenn, 16 USPQ2d 1730 (BPAI 1990), the Examiner had rejected an applicant's claims on the grounds that all of the claimed components were disclosed in a prior art reference (Roggenkamp). In that case it was found that although the prior art contained all elements of applicant's invention, the prior art indicated no preference for any particular component of one of the elements, i.e., the nonionic surfactant. The Board there held that, "... since we have been apprised of no disclosure within the Roggenkamp reference that would have led the routineer to make the critical selections to arrive at the claimed surfactant composition, we find that no prima facie case of obviousness has been established and that the rejection before us cannot be sustained." *Id.* at 1731 (emphasis added). Here too,

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there exists **no disclosure** within the '014 reference which would motivate one skilled in the art to: (1) choose to employ an emulsifier, particularly since its use is optional and would add cost to the finished formulation; (2) choose to employ a nonionic surfactant, rather than an amphoteric surfactant; (3) choose to employ a polyol, rather than any other type of nonionic surfactant; (4) choose to employ a polyol poly-12-hydroxystearate, rather than any of the other numerous polyol candidates; and (5) choose to employ the polyol poly-12-hydroxystearate in the claimed amount. Consequently, this element of the claimed invention is not believed to be rendered obvious by the teaching or suggestion of the '014 reference.

Moreover, with respect to the use of the claimed polyol poly-12-hydroxystearate in combination with both the waxy ester and wax components, it is clearly seen by way of the examples that the presence of all three components is necessary in order to achieve exceptional softness and skin feel. As a result, the unexpected results associated with the claimed invention are clearly NOT motivated anywhere within the teachings of the '014 reference.

With regards to the wax component, its use is also taught as being merely optional. If one chooses to use to substitute some of the water in the '014 formulation for an obviously more costly ingredient, then they need to then choose to decide to use either a wax component or an oil component. Here too, there exists **no disclosure** within the '014 reference which would motivate one skilled in the art to: (1) use a wax component which is clearly disclosed as being merely optional and which will add to the cost of the finished formulation; and (2) use wax rather than oil.

Accordingly, for all of the above-stated reasons, reconsideration and withdrawal of this rejection is respectfully requested.


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It is believed that the foregoing reply is completely responsive under 37 CFR 1.111 and that all grounds for rejection are completely avoided and/or overcome. A Notice of Allowance is therefore earnestly requested.

The Examiner is requested to telephone the undersigned attorney if any further questions remain which can be resolved by a telephone interview.

Respectfully submitted,

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